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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/616,214   | 07/14/2000  | Frederick Morgan     | CKB-001.01          | 5891             |
| 25181  | 7590        | 11/18/2005           | EXAMINER            |                  |
| FOLEY HOAG, LLP<br>PATENT GROUP, WORLD TRADE CENTER WEST<br>155 SEAPORT BLVD<br>BOSTON, MA 02110 |             |                      | SHECHTMAN, SEAN P   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2125                |                  |
| DATE MAILED: 11/18/2005  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                               |  |
|------------------------------|-------------------------------|-------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/616,214 | Applicant(s)<br>MORGAN ET AL. |  |
|                              | Examiner<br>Sean P. Shechtman | Art Unit<br>2125              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7-20, 22-31, 33, 78-92 and 107-128 is/are pending in the application.
- 4a) Of the above claim(s) 122-125 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-20, 22-31, 33, 78-92, 107-121 and 126-128 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-3, 5, 7-20, 22-31, 33, 78-92, 107-121, 126-128 are presented for examination.

Claims 122-125 have been withdrawn from consideration.

#### ***Election/Restrictions***

2. Applicant's election without traverse of claims 121 and 126-128 in the reply filed on August 31<sup>st</sup> 2005 is acknowledged.

#### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore,

referring to claim 84, the system wherein the controller is disposed within the processor;

referring to claim 118, the system wherein the sequence authoring interface is adapted to permit the user to specify a priority for a first lighting effect depending upon a cue received by the system;

referring to claim 119, the system wherein the sequence authoring interface is adapted to permit the user to specify a priority for a first lighting effect depending upon a cue received by the system, such that the priority specified by the user depending on a cue is a default priority; and

referring to claims 126-128, the system wherein the external stimuli is light, brightness of the light, and color of the light;

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 91 and 120 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 91 depends on claim 21. Claim 21 has been cancelled, thereby rendering claim 91 indefinite.

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5. Claim 120 recites the limitation "the same priority" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 17-20, 22-31, 33, 87, 89, 108 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Referring to claims 17-20, 22-31, 33, 87, 89, 108, the claims recite methods for preparing a lighting sequence. However, the claims describe the methods as an abstract idea in that the methods claimed can be implemented with paper files, without need for physical computing equipment and therefore constitute non-statutory subject matter. Examiner suggests the use of "computer implemented method" in place of "method" in order to make these claims describe statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 116, 121 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,962,687 to Belliveau et al (hereinafter referred to as Belliveau), supplied by applicant.

Referring to claims 116 and 121, Belliveau teaches a method and system for preparing a lighting sequence capable of being executed by a controller (Abstract), comprising:

a display interface displaying first information representative of a plurality of lighting effects (Fig. 1, Col. 4, lines 11-47, information representative of red light, green light); a processor coupled to the display interface and supporting a sequence authoring interface (Col. 6, line 62 – Col. 7, line 4) adapted to permit a user to select a lighting unit to execute a user selected lighting effect, based on the displayed first information (Col. 4, lines 11-47; Col. 6, lines 30-40); wherein

Referring to claim 116, Belliveau teaches the sequence authoring interface is adapted permit the user to select a transition effect for a transition between lighting effects (Col. 6, lines 1-9).

Referring to claims 121, Belliveau teaches the sequence authoring interface is adapted to permit the user to provide instructions to execute the selected lighting effect based upon at least one external stimulus (Col. 5, lines 51-68).

The claims, as such, are directed to a system not a method, and furthermore, the claims as such, do not require any ordering of the claimed elements. The examiner respectfully notes page 11, lines 11-13 of the instant specification which clearly teaches that the display interface is not limited by any description in the specification and “other techniques for visualizing a lighting sequence will be apparent to those of skill in the art and may be employed without departing from the scope and spirit of this disclosure”.

8. Claims 115, 116, 121 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,947,302 to Callahan (hereinafter referred to as Callahan).

Referring to claims 115, 116 and 121, Callahan teaches a method and system for preparing a lighting sequence capable of being executed by a controller (Abstract), comprising:

a display interface displaying first information representative of a plurality of lighting effects (Col. 15, lines 8-68); a processor coupled to the display interface and supporting a sequence authoring interface adapted to permit a user to select a lighting unit to execute a user selected lighting effect, based on the displayed first information (Col. 13, lines 38-65); wherein

Referring to claims 115, 116, Callahan teaches the sequence authoring interface is adapted permit the user to select a starting color and an ending color for the at least one selected lighting effect (Col. 12, lines 42-47; Cols. 35-36, claims 1-13).

Referring to claims 121, Callahan teaches the sequence authoring interface is adapted to permit the user to provide instructions to execute the selected lighting effect based upon at least one external stimulus (Col. 34, lines 38-62).

9. Claims 115-121 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,307,295 to Taylor et al (hereinafter referred to as Taylor).

Referring to claims 115, 116, 117, Taylor teaches a method and system for preparing a lighting sequence capable of being executed by a controller (Abstract), comprising:

a display interface displaying first information representative of a plurality of lighting effects (Col. 30, lines 32-46); a processor coupled to the display interface and supporting a sequence authoring interface adapted to permit a user to select a lighting unit to execute a user selected lighting effect, based on the displayed first information (Col. 30, lines 18-56); wherein

Referring to claims 115, 116, Taylor teaches the sequence authoring interface is adapted permit the user to select a starting color and an ending color for the at least one selected lighting effect (Col. 30, lines 18-56).

Referring to claims 117-120, Taylor teaches the sequence authoring interface is adapted to permit the user to specify a priority for lighting effects which share a temporal overlap; wherein the priority is dependent on the a cue and can be substituted (Col. 29, lines 49-65).

Referring to claims 121, Taylor teaches the sequence authoring interface is adapted to permit the user to provide instructions to execute the selected lighting effect based upon at least one external stimulus (Col. 6, lines 17-29).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 109-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of U.S. Pat. No. 6,031,343 to Recknagel et al (hereinafter referred to as Recknagel).

Referring to claims 109-114, Taylor teaches a method and system for preparing a lighting sequence capable of being executed by a controller (Abstract), comprising:

a display interface displaying first information representative of a plurality of lighting effects (Col. 30, lines 32-46); a processor coupled to the display interface and supporting a sequence authoring interface adapted to permit a user to select a lighting unit to execute a user selected lighting effect, based on the displayed first information (Col. 30, lines 18-56).

Referring to claims 109-114, Taylor fails to teach the system above, wherein the lighting unit includes a LED capable of emitting light of any of a range of different colors, and wherein



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the sequence authoring interface is adapted to permit the user to select an initial/final/range of color of light emitted by the LED.

However, Recknagel teaches analogous art, wherein referring to claims 109-114, Recknagel teaches a lighting unit includes a LED capable of emitting light of any of a range of different colors, and wherein a sequence authoring interface is adapted to permit the user to select an initial/final/range of color of light emitted by the LED (see Cols 12-13, Claims 10, 23, and 27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to combine the teachings of Recknagel with the teachings of Taylor.

One of ordinary skill in the art would have been motivated to combine these references because Recknagel teaches a multi-color lighting entertainment system (Col. 9, lines 14-44) wherein the LEDs of lighting modules can be controlled to emit more than just red, green, or blue, when combinations of LEDs are illuminated (Col. 4, lines 31-42).

11. Claims 126-128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor or Belliveau as applied to claim 121 above, and further in view of U.S. Pat. No. 6,495,964 to Muthu et al (hereinafter referred to as Muthu).

Referring to claims 126-128, Taylor or Belliveau teach all of the limitations set forth above, however, Taylor or Belliveau fails to teach the external stimulus is light brightness or color.

However, referring to claims 126-128, Muthu teaches analogous art, wherein the external stimulus is light brightness or color (Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to combine the teachings of Muthu with the teachings of Taylor or Belliveau.

One of ordinary skill in the art would have been motivated to combine these references because Muthu teaches comparing measured light outputs to desired outputs and automatically controlling lights to make changes to the power supply for the color blocks as necessary (Col. 2, lines 12-19).

### *Response to Arguments*

Applicant's arguments filed July 25<sup>th</sup> 2005 have been fully considered but they are not persuasive.

12. Regarding the drawings, the examiner respectfully invites applicant's attention to 37 C.F.R 1.83(a) which clearly states:

“(a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).”

The objections to the drawings are maintained and further objections have been set forth because the examiner believes that the drawings, as such, do not show every feature of the invention specified in the claims.

13. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., selecting a priority among first and second lighting effects to be executed by a lighting unit; subsequent to the user input, an external stimulus can alter the execution of a lighting effect) are not recited in

the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. Applicant's arguments, see pages 16-17, filed July 25<sup>th</sup> 2005, with respect to the 35 U.S.C. 103(a) rejections of claims 1-3, 7, 8, 11, 13, 14, 16-20, 22, 23, 25-29, 31, 78-81, 83, 86-92, 107, and 108 as being unpatentable over U.S. Pat. No 6,466,234 to Pyle in view of U.S. Pat. No. 5,889,514 to Boezeman have been fully considered and are persuasive. The 35 U.S.C. 103(a) rejections of claims 1-3, 7, 8, 11, 13, 14, 16-20, 22, 23, 25-29, 31, 78-81, 83, 86-92, 107, and 108 as being unpatentable over U.S. Pat. No 6,466,234 to Pyle in view of U.S. Pat. No. 5,889,514 to Boezeman has been withdrawn.

15. All other arguments with respect to claims 1-3, 5, 7-20, 22-31, 33, 78-92, 107-121, 126-128 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

16. The prior art or art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents or publications are cited to further show the state of the art with respect to a multimedia authoring tool with a timeline for multimedia presentations such as light shows.

U.S. Pat/Pub. No. 5,659,793 to Escobar et al (See col. 1).

The following patents or publications are cited to further show the state of the art with respect to a media authoring tool with a timeline for time-based media such as lighting controls, wherein a component positioned on the timeline can be a dim or bright component.

U.S. Pat/Pub. No. 2003/0018609 to Phillips et al (See claim 1, and paragraph 65).

The following patents or publications are cited to further show the state of the art with respect to a lighting sequence authoring tool with a timeline for lighting effects.

[www.jandsvista.com/features.html](http://www.jandsvista.com/features.html), 11/8/05.

Congo, The Avab board by ETC, datasheet from Electronic Theatre Controls, June 6<sup>th</sup> 2005.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean P. Shechtman whose telephone number is (571) 272-3754. The examiner can normally be reached on 9:30am-6:00pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P. Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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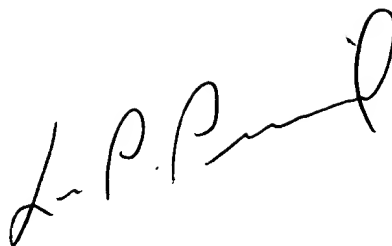
Sean P. Shechtman

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November 7, 2005

A handwritten signature in black ink, appearing to read "L. P. Picard", written in a cursive style.

**LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100**